

**REMARKS**

Upon entry of the present amendment, claims 1, 3, 7-14, and 16-24 are pending in the application, of which claims 1, 16, 20-22, and 24 are independent.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted. It is submitted that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**In the Specification**

In the above-identified Office Action, the Examiner objected to the disclosure because of informalities. The amendments to the specification herein overcome these objections. Specifically, on page 3, the phrase "second said side wall portion" has been amended to --second side wall portion--, and on page 6, line 2, the phrase "door panel P" has been amended to --door panel DP--per the suggestions of the Examiner.

**In the Claims****Claim Objections**

In the above-identified Office Action, Claims 14, 15, and 19 were objected to because of informalities. The amendments to claims 14 and 19 herein, in which the phrase "second said side wall portion" has been amended to --second side wall portion--, overcome these objections.

**Claim Rejections – 35 USC 112**

In the above-identified Office Action, claims 1-19 were rejected under 35 USC 112, second paragraph, as indefinite because insufficient antecedent basis was provided for the limitation “said receptacle” in claims 1, 3, 8, and 16.

Claims 1, 3, 8, and 16 have been amended herein so that the phrase “said receptacle” now recites --said receptacle case--. These amendments to claims 1, 3, 8 and 16 render these claims definite and overcome the rejection under 35 USC 112, second paragraph.

**Claim Rejections – 35 USC 103**

Also in the above-identified Office Action, the Examiner rejected claims 1, 3, and 7-14 under 35 USC 103(a) as unpatentable over Cannon et al (6,116,672) in view of Gillie (5,598,854) and McAndrew et al. (2001/0052715).

The Examiner states that Cannon discloses a storage receptacle for use with a pocket on a vehicle door including a receptacle case comprising at least one sidewall, a floor formed integrally with the sidewall, and a lip substantially horizontally outwardly from a top portion of the sidewall, provided for placement over an upper edge portion of a vehicle door pocket, but does not disclose the sidewall having a gap extending downward from a top portion thereof.

The Examiner cites Gillie as a reference which shows a gap in an ashtray sidewall, and McAndrew as a reference teaching the possibility of including an ashtray in a vehicle door pocket, stating that it would be obvious to make the receptacle case of Cannon an ashtray bin in order to provide a storage receptacle for cigarette ashes, and it would further be obvious to modify the ashtray in the receptacle case according to Gillie.

**The Standard for Obviousness under Federal Circuit Law**

Applicant respectfully wishes to call the Examiner's attention to some relevant cases of

the U.S. Court of Appeals for the Federal Circuit (CAFC). The CAFC was established in 1982 to bring national standards, and a certain level of conformity and continuity to Federal patent case law. Decisions of the Federal Circuit are relevant and helpful in giving guidance to private patent practitioners, as well as to the personnel of the U.S. Patent and Trademark Office.

The U.S. Court of Appeals for the Federal Circuit has said that a reference must be viewed in its entirety, *Gore v. Garlock*, 220 U.S.P.Q. 303 (CAFC 1983) and that it is impermissible to use the claims as a frame, and the references as a mosaic, to pick and choose selected pieces, out of context, to reconstruct the invention, *Northern Telecom v. Datapoint*, 908 F.2d 931 (CAFC 1990).

The U.S. Court of Appeals for the Federal Circuit has also said that that in order to combine references, the Examiner must show some motivation, suggestion, or teaching of the desirability of making the combination, *In re Dembiczkak*, 50 USPQ 2d 1614, 1617 (CAFC 1999); and that the use of hindsight, in evaluating patentability, is improper, *In re Werner Kotzab*, 55 U.S.P.Q. 2d 1313 (CAFC 2000); *Gore v. Garlock, supra*.

Specifically, in *Kotzab*, *supra*, the CAFC stated:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.*

Most, if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a

combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (citations omitted).

Applicant respectfully suggests that the Examiner appears to be evaluating applicant's invention using improper hindsight, picking and choosing selected portions of the references and combining those selected portions to reconstruct a mosaic of applicant's invention. Applicant respectfully suggests that such an approach is not consistent with the standards set out in the above-quoted cases of the CAFC, and respectfully requests that the rejection of claim 1 be reconsidered and withdrawn.

As regards claims 3 and 7-14, the Examiner states that Canon, as twice modified, discloses the claimed invention. The applicant respectfully disagrees with the rejection of these claims for reasons stated above with respect to claim 1. The Examiner has shown no motivation, teaching or suggestion in the references that Canon be once modified, and in particular, has shown no motivation, teaching or suggestion to twice-modify Canon, unless impermissible hindsight is used.

In the applicant's review of the Gillie and McAndrew references, it is noted that Gillie is not related in any way to vehicles or to storage receptacles for use in automotive doors. Instead, Gillie relates to mechanical fire extinguishing structures (Gillie, column 1, lines 7-10). Applicant respectfully submits that Gillie is not analogous art to the present invention.

Gillie discloses an ashtray including an extinguishing device for snuffing out a burning cigarette. The ashtray of Gillie includes a hollow cylindrical ashtray body 12 having a plurality of notches 20 formed in the perimeter side wall 18 for supporting a cigarette relative to the body 12.

McAndrew discloses a control panel located within an armrest portion of an interior door panel of a vehicle. The control panel includes a housing, and a recess 32 formed within the housing below the control panel, whereas the control panel is pivotally attached to the housing and acts as a lid for the recess 32. The control panel includes a first bank of controls 44 mounted to the exterior surface of the lid. The recess may hold a second bank of controls 70, or alternatively may be used as a "coin/ashtray bin".

It is the Examiner's position that it would be obvious to modify the vehicle door pocket insert disclosed by Cannon to include an ashtray bin as taught by McAndrew, and then to further modify the ashtray bin thus derived, to include downwardly extending gaps as taught by Gillie.

The applicant respectfully disagrees with this rejection. Cannon discloses an insert 24 which rests within a preexisting door pocket. The insert 24 can be used as is, or in combination with an adaptor ring 72. The insert includes a frame 26 which has a lip 28 (FIG 1) formed along the upper surface thereof. When the frame 26 is inserted into the vehicle door pocket, the lip 28 rests upon and engages the top edge of pocket sidewall 20 (col. 3, line 55). Although the lip 28 of Cannon's insert could be modified to include downwardly extending gaps, there would be no benefit in doing so, since such openings would be obstructed by the pocket sidewall 20 when the insert of Cannon is received within the vehicle door pocket.

The applicant respectfully asserts that modification of Cannon by the teachings of McAndrew and Gillie has no practical benefit, and thus there is no motivation for this modification.

The applicant also respectfully asserts that although McAndrew teaches positioning of an ashtray within a door panel, this teaching cannot be generalized to conclude that an insert for a vehicle door pocket should be modified to provide an ashtray. Ashtrays are generally provided in

all vehicles as a standard feature by the vehicle manufacturer, either in the center console or within the door panel, so as to be within easy access of the front seat occupants. Additional ashtrays are, similarly, normally provided in the rear seat area within easy access of the rear seat occupants. Because ashtrays are pre-existing within the vehicle and are easily accessible, there is no reason or motivation to provide additional ashtrays within the vehicle door pocket.

Further, although Cannon describes an insert used to store a wide variety of objects, use of the insert as an ashtray is not disclosed by Cannon. Neither McAndrew nor Gillic suggests modification of vehicle storage space to form additional ashtrays within a vehicle. Thus, none of the references, nor their combination, suggest modification of Cannon to form an ash tray therein.

#### **Allowable Subject Matter**

The applicant gratefully acknowledges the Examiner's indication that claims 2, 4-6 and 15-19 contain allowable subject matter.

In the Office Action, claims 2, 4-6, and 15 were objected to as being dependent upon a rejected base claim, but were indicated as allowable if rewritten in independent form.

New independent claims 20-22 and 24 have been added to the application that correspond to dependent claims 2, 4, 6 and 15, respectively, which have been rewritten to include the limitations of claim 1 and any intervening claims per the suggestion of the Examiner. New dependent claim 23 is similar to original claim 5, but depends from claim 22.

New claims 20-24 are considered to be condition for allowance.

#### **Other Matters**

The prior art made of record by the Examiner and not relied upon, has been reviewed by the applicant. The applicant submits that no reasonable reading of the references, either singly or

in combination, can be viewed as teaching the applicant's claimed invention.

For all of the above mentioned reasons, applicant requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.

Applicant respectfully submits that the above amendments are fully supported by the original disclosure, including the drawings and claims, no new matter is introduced by the above amendments. The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner is not fully convinced of the allowability all of the claims now in the application, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve prosecution of the application.

The Commissioner is hereby authorized to charge \$264.00 for three independent claims in excess of three, as well as to charge any deficiency which may be required during the entire pendency of the application, and to credit any excess paid during the entire pendency of the application, to Deposit Account 50-0744 in the name of Carrier, Blackman & Associates, P.C. A duplicate copy of this sheet is enclosed.



Favorable reconsideration is respectfully requested.

Respectfully submitted,



William Blackman  
Attorney for Applicant  
Registration No. 32,397  
(248) 344-4422

Customer No. 21828  
Carrier, Blackman & Associates, P.C.  
24101 Novi Rd, Ste. 100  
Novi, Michigan 48375  
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#### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent via facsimile transmission to the US Patent & Trademark Office, Art Unit 3612, on October 26, 2004, at the number (703) 872-9306.

